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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/780,273
Filing Date: February 09, 2001
Appellant(s): FROSETH ET AL.

MAILED
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Everett G. Diederiks, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 7, 2007 appealing from the Office action mailed August 15, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

NEW GROUND(S) OF REJECTION

Claims 128-130 are rejected under 35 U.S.C. 102(b) as being anticipated by Ezzat (GB 2,250,266).

Claims 131-146 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezzat (GB 2,250,266) in view of Mohlenkamp Jr. et al. (US 5,120,563), and Google Groups (12/9/1999)

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2250266	Ezzat	6-1992
2,802,599	Callahan, et al.	8-1957
5,997,924	Olander, Jr. et al.	12-1999
5,120,563	Mohlenkamp, Jr. et al.	6-1992

Google Groups, "Make Your Own LC Gift Baskets" alt.support.diet.low-carb, Dec. 9, 1999, page 3 of 7

Splenda Website:

<http://www.splenda.com/page.jhtml?id=splenda/newspromotions/press/timelines.inc>

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- **Claim 128 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Instant claim 128 recites the limitation customized. The claim is unclear as to what Applicant regards as a customized food product.

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- **Claims 128-130 are rejected under 35 U.S.C. 102(b) as being anticipated by Ezzat (GB 2,250,266).**

Ezzat discloses preparing popcorn in a microwave oven by placing butter, salt, sugar (a sweetener) and unpopped kernels in a microwave package (Page 2, Line 7; Page 3, Lines 1-23), which would involve opening the package after popping. It is thus known that upon popping the unpopped kernels the consumer has further finished the product by popping in a microwave that, therefore, cooks the food product. Ezzat's invention is considered customized: during the process food packages containing butter, sugar, salt or a combination thereof have been dispensed into the container with unpopped kernels. The consumer then *selects* a product upon purchase that suits the consumer's needs and preferences.

- **Claims 128 is rejected under 35 U.S.C. 102(b) as being anticipated by Callahan et al (US 2,802,599).**

Callahan discloses a food customized food product (Column 1, Lines 56-58) that incorporates customer selected additives (Column 4, Lines 36-45) and is then packaged in a container (Column 3, Lines 15-17).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international

Art Unit: 1761

application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- **Claims 128 is rejected under 35 U.S.C. 102(e) as being anticipated by Olander, Jr. et al (US 5,997,924).**

Olander discloses a customized food product where the food ingredient is selected by the consumer (Column 2, Lines 8-10), additives can be incorporated onto the uncooked food ingredient (Column 2, Lines 22-24), and dispensed into a package that is appropriate for the handling of the chosen food product (Column 2, Lines 26-29). The examiner understands that additives are additions that are incorporated into or onto the food product. Olander discloses that the food product can them be dispensed or packaged by several means.

- **Claims 131-146 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezzat in view of Mohlenkamp Jr. et al (US 5,120,563) and Google Groups.**

Ezzat discloses as discussed above. Ezzat does not disclose the sweetener to be sucralose or acesulfame K. Mohlenkamp discloses the use of alternatives to table sugar (sucrose) such as acesulfame K for use in food products (Column 16, Lines 51-66; Column 17, Lines 1-10) for

Art Unit: 1761

reduced calorie diets (Column 17, Line 66). Google Groups discloses how to make a low carbohydrate sweet and salty popcorn by combining commercially available microwave popcorn with sucralose, as opposed to another sugar alternative, SugarTwin®.

With regard to Claims 131-133, 135, 136, 138, 140-143, 145 and 146, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify Ezzat as taught by Google Groups in order to provide another substitute sweetener to be incorporated into a food product, such as popcorn, for a low carbohydrate low calorie diet. It is further known that sweeteners exist as a substitute to sugar for diet conscious consumers. Sucralose provides an alternative option to known sweeteners such as aspartame, saccharin, acesulfame, which have been studies to cause health side effects. Thus it would have been obvious to incorporate this sweetener as well into a packaged food product. Furthermore, with regards to Claims 138-143, it would have been obvious that in order to provide the food product as disclosed by Ezzat and taught by Google Groups and Mohlenkamp, a process would be required to provide such a food product for a consumer.

With regard to Claims 134, 137 and 139 it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify Ezzat as taught by Mohlenkamp in order to provide a substitute to the sugar that is added to the food package. It is obvious that

Art Unit: 1761

there are several reasons for which substitutes to table sugars have been developed; one of those reasons being to provide a reduced calorie sweetener for products. Since sweeteners such as acesulfame K provide the same function as sugar with a lower caloric intake, it would have been obvious to incorporate sugar substitutes as well into the process of providing a food package that contains additives such as sweeteners.

Regarding instant claim 144, Ezzat teaches on page 1, Line 17, adding flavorings including salt, sugar, butter, etc., thus teaching salt as one of the constituents used for flavoring. On page 3, lines 6-9, Ezzat further teaches adding said spices to packaged popcorn.

- **Claims 138-143 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezzat/Google Groups/Mohlenkamp Jr. in further view of Callahan.**

Ezzat/Google Groups/Mohlenkamp disclose as discussed above. Callahan discloses as discussed above. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to further modify Ezzat/Google Groups/Mohlenkamp as taught by Callahan in order to provide a self-service system for obtaining a customizable product.

(10) Response to Argument

- Regarding instant claim 128, at pages 4-5 of the Appeal Brief, appellant states that,

The title of the Application includes the word "customized", the Field section of the application states "the present invention relates to systems and methods of ordering and distributing food, and in particular to a customized food selection, ordering and distribution system and method", the background and/or Summary talk about allowing consumers to "create a customized food product" based on available selections such as by telephone, the internet or the like and the specification has incredibly detailed description with reference to forty-nine drawings.

As set forth in the MPEP, definiteness of claim language must be analyzed, not in a vacuum, but in light of (a) the content of the particular application disclosure; (b) the teachings of the prior art; and (c) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. See MPEP 2173.02. The appellant respectfully submits that the term "customized" when read in the proper light based on the disclosure, has a clear and definite meaning.

This argument is not deemed persuasive. Although the claims are to be read in light of the specification, the Examiner asserts that, as *claimed*, the limitation "customized" is unduly broad, as further indicated by the rejections set forth under 35 U.S.C. 102(b). The instant claim recites "a customized food product comprising..." Based on the level of skill of one having ordinary skill in the art, a packaged product with sweet flavor versus the packaged product with a savory flavor, for example, can be considered customized such that the consumer can choose between two choices. If the consumer preferred savory products the savory

flavored product would have thus been customized to the consumer's taste. Therefore the final product can be considered a customized product. Additionally, in light of appellant's disclosure and the skill level of one possessing ordinary skill in the art, the term customized can read on almost any food product wherein a choice has been made at some point in the product's production as to the ingredients used.

- Regarding instant claims 128-130, on pages 6-7 of the Appeal Brief, appellant states that Ezzat does not provide a teaching or suggestion for consumer customization of a packaged food product as required in claim 128. Ezzat discusses a sealed bag containing corn kernels and spices which are popped to form classic popcorn. Appellant further states that Ezzat is specifically concerned with preparing a predetermined, pre-packaged food product which a consumer would have to directly select off a supermarket shelf or the like. The consumer only determines whether to buy the product, but has no direct input on the contents of the main ingredient, on the decision of the particular additive(s) included or on the selection of the package in which the ingredients and additives are placed. Appellant further states that clearly, the consumer did not have an input into which particular container the ingredients were placed. Instead, the decision is predetermined by the manufacturer. Given a proper interpretation and patentable weight to the customized aspect of the invention, Ezzat cannot be considered to anticipate the present invention.

This argument is not deemed persuasive. The Examiner notes that the instantly claimed limitations do not recite wherein the consumer has direct input on the contents of the main ingredient, on the decision of the particular additive(s) included or on the selection of the package in which the ingredients and additives are placed. Instead, the claims simply state that a food ingredient is selected by a consumer and the additive is

selected by the consumer and the package is selected by the consumer. There is a difference, which has not been claimed, between the limitation of merely selecting a package versus providing input on the contents of the main ingredient and on the decision of a particular additive. Even further still, the instant claim is drawn to a product and more so to a finished product comprising a food ingredient, an additive and is packaged. Therefore, even the teachings of Ezzat, who teach a packaged popcorn product, can be considered a customized product. This is further the case since when a consumer purchases the packaged popcorn product, the consumer is intrinsically selecting the packaging, the food ingredient and the additive that has been placed in the package. If the consumer did not like the flavor or a specific additive that was added in the package, the consumer would have most likely preferred an alternative food product or would not have purchased the product. If the packaging were inadequate or damaged or unappealing, it would more likely have drawn the customer away from the product. The Examiner respectfully asserts that although packaged, by purchasing the product, the consumer is selecting a product that is "customized" to his/her tastes and thus is selecting the ingredients, additives and packaging that are incorporated with the product.

Art Unit: 1761

- Regarding instant claim 144, the Examiner had inadvertently rejected instant claim 144 under 35 U.S.C. 102(b) however this claim is dependent on instant claim 131 which has been rejected under 35 U.S.C. 103(a). Thus, claim 144 has been incorporated into the new grounds for rejection, above of claims 131-146 under 35 U.S.C. 103(a) as being unpatentable over Ezzat in view of Mohlenkamp Jr. et al. and Google Groups, as indicated in the new grounds for rejection. As discussed above, Ezzat teaches adding spices such as salt, sugar, butter, etc., onto popcorn and further teach adding said spices onto packaged popcorn which is then popped by the consumer (Page 3, Lines 6-9)
- Regarding instant claim 128, at pages 7-8 of the Appeal Brief, appellant states that, Callahan does not disclose the combination of a food selected by a consumer and a package selected by the consumer. Appellant submits that obtaining coffee from a coffee vending machine does not equate to the customized food product of the invention, particularly as the claimed limitations cannot be read in a vacuum but must be read in light of the specification. First a beverage is not a food product, as claimed. Appellant states that the present specification clearly references only edible items when referring to the resulting food product. Appellant further argues that the machine in Callahan only dispenses coffee and therefore the consumer does not select a food ingredient in a manner analogous to the invention and further that the package of the invention must contain the food ingredient and the additive. Consistent with the customization of the invention, the package is sealed in order to "contain" the food ingredient and additive, unlike the arrangement of Callahan.

This argument is not persuasive. The Examiner also applies the reasoning above regarding selecting an ingredient to Callahan.

Additionally, the Examiner respectfully asserts that by obtaining coffee, the

Art Unit: 1761

consumer would have been selecting the food ingredient – in this case, coffee. As disclosed by Callahan, the consumer can select coffee, coffee with sugar, coffee with cream and coffee with cream and sugar (Column 4, Lines 36-39). The instant claim only recites selecting a food ingredient. Therefore, the consumer would be selecting the food ingredient, coffee, and an additive such as cream or cream and sugar, and is also selecting a package. In this case, the package is the cup within which the product is dispensed. The Examiner also respectfully asserts that as claimed, coffee would still be considered a food product since it is an edible item.

- Regarding instant claim 128, at pages 8-9 of the Appeal Brief, appellant states that Olander, Jr. et al., is not concerned with the claimed invention and that nowhere in Olander, Jr. et al., is there a teaching or suggestion for a customized food product comprising a food ingredient selected by a consumer and additive selected by the consumer and a package selected by the consumer. Rather in Olander, an automated pizza making process includes the step of putting a cooked pizza into a predetermined container. The fact that the container used in the automated process of Olander could be any one of a number of container types is irrelevant as the consumer does not select the packaging.

This argument is not persuasive. As applied above, by purchasing a food product contained in a package, the consumer is also selecting the package into which the food product is placed. Additionally, in disclosing that the container in which the pizza can be placed can be a carton, container, package, plastic plate, paper plate or cardboard pizza box (Column 4, Line 64 to Column 5, Line 1). Therefore if the consumer only

Art Unit: 1761

selected a slice, the consumer would not have received the slice in the same cardboard box as that of a whole pizza, but rather on a plate or a smaller box. Therefore, the selection of the package is intrinsically selected with the type of food. Even further still, Olander, Jr. discloses on column 5, lines 11-14 that the consumer name, the type of pizza, list of toppings, etc, is printed on the pizza box. Therefore, the box is customized to the consumers selected food product.

- Regarding instant claims 131 and 132, at pages 9-10 of the Appeal Brief, appellant states that the combined prior art references do not teach or suggest all the limitations of claim 131 and that there is no teaching in the applied prior art to make a customized food product analogous to the present invention.

As discussed above, the Examiner respectfully asserts that when the consumer selects the packaged product of Ezzat, the consumer would intrinsically select the food ingredient, additive and package. The packaged product of Ezzat would thus be a customized product.

- At page 10 of the Appeal Brief, appellant states that it is not clear as to why Mohlenkamp is pertinent since the limitation of acesulfame K is in claims 134, 137 and 139 and not in claims 131 and 132.

The Examiner asserts that Mohlenkamp is relied on to teach using alternatives to table sugar for the purpose of providing low calorie sweeteners for use in food product for reduced calorie diets (Column 16,

Lines 51-66; Column 17, Lines 1-10 and 66). Therefore, Mohlenkamp is relied on as motivation for providing sugar substitutes.

- At page 11, of the Appeal Brief, appellant states that the Google Groups reference only suggests sprinkling Splenda® (sucralose) on previously popped popcorn instead of SugarTwin®. At best this combination would suggest sprinkling sucralose onto popcorn of Ezzat after the popcorn is cooked. In contrast, claims 131 and 132 require the sucralose to be pre-packaged with the popcorn. Therefore, none of the prior art, taken either alone or in combination, teaches or suggests a packaged popcorn product including sucralose.

The Examiner asserts that Mohlenkamp is relied on to teach providing substitutes to sugar for reduced calorie diets (Column 1, Lines 23-29; Column 17, Line 55 to Column 18, Line 6) and wherein the sugar substitutes have been included prior to cooking the food product (Column 16, Lines 51-65). Google Groups has been relied on as a generic teaching of the concept of applying another sugar alternative, Splenda® (i.e. sucralose) to popcorn products. Although Google Groups teaches adding sucralose after popping the popcorn, Google Groups also provides the generic teaching of sucralose as an alternative sweetener to sugar, which has been applied to food products such as popcorn. Therefore based on the teachings of Mohlenkamp who teaches using sugar substitutes in combination with Google Groups, which teaches that it has been known to use the sugar substitute Splenda® (sucralose) on popcorn, it would have been obvious to one having ordinary skill in the art to use

Art Unit: 1761

sucralose since Google Groups teaches sucralose as another substitute sweetener to be incorporated into a food product.

- Regarding instant claim 133, on page 11 of the Appeal Brief, appellant states that the Google Groups reference is only limited to suggesting the sprinkling of sucralose on popcorn after the popcorn has been popped and the limitations of instant claim 133 further distinguish the invention since the sucralose is added before cooking.

The Examiner asserts that Mohlenkamp teaches that sugar substitutes (or alternative sweeteners) have been well known to be used in food products prior to cooking for the purpose of providing a low calorie alternative for diet conscious consumers (Column 1, Lines 23-29). In disclosing that the food product can be baked in a conventional oven or in a microwave oven (Column 16, Lines 56-61), Mohlenkamp also teaches the successful use of sugar alternatives in conventional oven and microwave oven environments. Although Google Groups teaches applying sucralose after the popcorn has been popped, the Examiner respectfully asserts that Google Groups is relied on as a generic teaching that sucralose was available at the time of the invention as a sugar alternative and further teaches applying sucralose to a food product. As stated in the response to arguments in the final Office Action, the Examiner has provided a reference from the Splenda® website indicating that since April 1999, sucralose has received FDA approval for consumer sale. Mohlenkamp teaches that such sugar substitutes have been

successfully used to replace sugar in microwave cooked food products; therefore it would have been obvious to use a sugar substitute for the product of Ezzat for the purpose of providing a low calorie sweetener alternative for health conscious consumers.

- Regarding instant claim 134, on page 12 of the Appeal Brief, appellant states that with respect to the combination, that there is simply no reason of record, absent hindsight of the present invention, to utilize both sucralose and acesulfame K as sweeteners on the popcorn of Ezzat.

The Examiner asserts that Mohlenkamp teaches several sugar alternatives that can be used (Column 15, Lines 31-37 and Column 17, Lines 55-67). On Column 15, Lines 20-37, Mohlenkamp teaches that the sugar component of the food compositions can comprise the reduce calorie sugar and regular calorie sugars and that the reduced calorie sugar is present as a mixture of between 10 to 100% and preferably from about 50 to 100% of the sugar component. This teaches to the ordinarily skilled artisan that more than one sweetener can be combined to form the sugar component used in the food product. In Examples 1-3 (See the tables associated with each example), Mohlenkamp also teaches adding aspartame and a reduced calorie sugar into the food products, thus teachings blend of alternative sweeteners. Therefore, Mohlenkamp is broadly relied on to teach blends of sweeteners to be added to the food product prior to cooking. Therefore to use another alternative sweetener to

sugar, such as sucralose, which Google Groups teaches was available as an alternative sweetener to sugar, would have been within the skill level of one having ordinary skill in the art.

Even further still, the Examiner asserts that it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. (See MPEP 2144.06). In this case, the prior art teaches using sucralose as an alternative to sugar and also teaches using acesulfame K as an alternative to sugar. In both Google Groups and Mohlenkamp, the substitute sweetener has been used to lower the caloric intake of the consumer when consuming the sweetened product. Therefore, to combine both sucralose and acesulfame K would not have provided a patentable feature over the prior art since the prior art teaches both of these compositions to be used for the same purpose.

- Regarding instant claim 135 and 145, at page 12 of the Appeal Brief, appellant further states that Google Groups suggest sprinkling sucralose on popped popcorn instead of SugarTwin® and thus this combination would suggest sprinkling sucralose onto the popcorn of Ezzat after the popcorn is cooked.

As discussed above, the Examiner asserts that although Google Groups teaches applying sucralose after the popcorn has been popped, Google Groups teaches that sucralose was available at the time of the invention as a sugar alternative and further teaches applying sucralose to

a food product for the purpose of providing a low calorie sweetening alternative. As stated in the response to arguments in the final Office Action, the Examiner has provided a reference from the Splenda® website indicating that since April 1999, sucralose has received FDA approval for consumer sale. Mohlenkamp teaches that such sugar substitutes have been successfully used to replace sugar in microwave cooked food products (Column 16, Lines 51-65); therefore it would have been obvious to use a sugar substitute for the product of Ezzat for the purpose of providing a low calorie sweetener alternative for health conscious consumers. Furthermore, based on the teachings of Mohlenkamp who teaches using sugar substitutes in combination with Google Groups, which teaches that it has been known to use the sugar substitute Splenda® (sucralose) on popcorn, it would have been obvious to one having ordinary skill in the art to use sucralose since Google Groups teaches sucralose as another substitute sweetener to be incorporated into a food product.

- Regarding instant claim 136, at page 13 of the Appeal Brief, appellant states that there is no motivation provided by Google Groups to utilize Splenda in a packaged uncooked popcorn product. Appellant further states that the Examiner appears to be arguing that sucralose and sugar are equivalents. Appellant asserts that that sugar and sugar substitutes have different chemical structures and react in vastly different ways when processed, consumed and/or heated. Therefore there is no suggestion in Ezzat as to the desirability of using a sugar substitute for any purpose and the Google Groups reference is actually seen to teach away from applying sucralose to popcorn prior to popping of the popcorn.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Although Google Groups teaches adding sucralose after popping the popcorn, the Examiner asserts that Google Groups is relied on as a generic teaching that sucralose has been a known substitute sweetener to sugar, which has been used on food products such as popcorn. This is not considered a teaching away but rather a generic teaching that sucralose was also available to the skilled artisan as an alternative low calorie sweetener to sugar. Mohlenkamp, as discussed above, teaches incorporating reduced calorie sugars and sugar substitutes such as aspartame and acesulfame K into food products that are prepared in a microwave oven. In combination with the knowledge of the ordinarily skilled artisan, it would have been obvious to use the sugar substitutes of Mohlenkamp and Google Groups in the food product of Ezzat for the purpose of providing low calorie alternative sweetening agents for the diet conscious consumer. Regarding appellant's assertion that the Examiner appears to be arguing that sucralose and sugar are equivalents, it is unclear as to where this has been stated in the Office Action. The Examiner has states that sweeteners exists as substitutes to sugar. This has been intended to

Art Unit: 1761

indicate that sugar and sugar substitutes are both sweeteners intended to be used to sweeten a food product. The Examiner has not contended that sucralose and sugar are equivalents, but rather that alternatives to sugar have been utilized (i.e. as substitutes) for sweetening food products.

- Regarding instant claim 137, on page 14 of the Appeal Brief, appellant states that in combination the Examiner lacks any suggestion to even utilize multiple different sweetening ingredients with packaged popcorn, let alone the specific combination of sucralose and acesulfame K.

The Examiner asserts that Mohlenkamp teaches several sugar alternatives that can be used (Column 15, Lines 31-37 and Column 17, Lines 55-67). On Column 15, Lines 20-37, Mohlenkamp teaches that the sugar component of the food compositions can comprise the reduce calorie sugar and regular calorie sugars and that the reduced calorie sugar is present as a mixture of between 10 to 100% and preferably from about 50 to 100% of the sugar component. This teaches to the ordinarily skilled artisan that more than one sweetener can be combined to form the sugar component used in the food product. In Examples 1-3 (See the tables associated with each example), Mohlenkamp also teaches adding aspartame and a reduced calorie sugar into the food products, thus teachings blend of alternative sweeteners. Therefore, Mohlenkamp is broadly relied on to teach blends of sweeteners to be added to the food product prior to cooking. Therefore to use another alternative sweetener to

sugar, such as sucralose, which Google Groups teaches was available as an alternative sweetener to sugar, would have been within the skill level of one having ordinary skill in the art.

Even further still, the Examiner asserts that it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. (See MPEP 2144.06). In this case, the prior art teaches using sucralose as an alternative to sugar and also teaches using acesulfame K as an alternative to sugar. In both Google Groups and Mohlenkamp, the substitute sweetener has been used to lower the caloric intake of the consumer when consuming the sweetened product. Therefore, to combine both sucralose and acesulfame K would not have provided a patentable feature over the prior art since the prior art teaches both of these compositions to be used for the same purpose.

- Regarding instant claims 138, 140 and 146, on page 14 of the Appeal Brief, appellant states that the instant claims require the sucralose to be prepackaged with the popcorn for distribution and that in the combination suggested by the Examiner, at best, the sucralose would be subsequently added as the Google Groups reference only suggests a subsequent application such that no method is disclosed or suggested by the applied prior art wherein sucralose is added to the popcorn and packaged for distribution.

Ezzat teaches adding salt, sugar and butter to the popcorn and subsequently packaging said popcorn. Therefore, Ezzat teaches the

method of adding a sweetener to popcorn, prior to popping, and packaging the popcorn for distribution. After the consumer purchases the popcorn it is popped. Ezzat is silent in teaching using sucralose, however Mohlenkamp teaches sugar substitutes used in foods that have been cooked in a microwave and Google Groups teaches that sucralose has been a known low calorie substitute sweetener used in place of sugar. Although Google Groups teaches adding sucralose after popping the popcorn, the Examiner asserts that Google Groups is relied on as a generic teaching that sucralose has been a known substitute sweetener to sugar which has been used on food products such as popcorn. Therefore, it would have been obvious to one having ordinary skill in the art to add a sugar substitute such as Splenda® (sucralose) since Google Groups teaches this as a low calorie sweetening alternative, which would have been available to the ordinarily skilled artisan and since Mohlenkamp teaches adding reduced calorie sweeteners prior to cooking the food product. Nevertheless, since Mohlenkamp teaches microwave cooking with reduced calorie sweeteners, there would have been a reasonable expectation of success in adding a specific sugar substitute such as sucralose prior to popping the popcorn of Ezzat, since Mohlenkamp broadly teaches several substitute sweeteners to sugar (Column 17, Line 55 to Column 18, Line 6) that are added to the food product prior to cooking and wherein the product is cooked in a microwave.

- Regarding instant claim 139, on page 15 of the Appeal Brief, appellant states that there is no teaching or suggestion in the applied prior art to further add acesulfame K to the sucralose and popcorn packaged in accordance with claim 135. That is, the combination lacks any suggestion to utilize multiple different sweetening ingredients with packaged popcorn, let alone the specific combination of sucralose and acesulfame K.

The Examiner asserts that Mohlenkamp teaches several sugar alternatives that can be used (Column 15, Lines 31-37 and Column 17, Lines 55-67). On Column 15, Lines 20-37, Mohlenkamp teaches that the sugar component of the food compositions can comprise the reduce calorie sugar and regular calorie sugars and that the reduced calorie sugar is present as a mixture of between 10 to 100% and preferably from about 50 to 100% of the sugar component. This teaches to the ordinarily skilled artisan that more than one sweetener can be combined to form the sugar component used in the food product. In Examples 1-3 (See the tables associated with each example), Mohlenkamp also teaches adding aspartame and a reduced calorie sugar into the food products, thus teachings blend of alternative sweeteners. Therefore, Mohlenkamp is broadly relied on to teach blends of sweeteners to be added to the food product prior to cooking. Therefore to use another alternative sweetener to sugar, such as sucralose, which Google Groups teaches was available as an alternative sweetener to sugar, would have been within the skill level of one having ordinary skill in the art.

Even further still, the Examiner asserts that it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. (See MPEP 2144.06). In this case, the prior art teaches using sucralose as an alternative to sugar and also teaches using acesulfame K as an alternative to sugar. In both Google Groups and Mohlenkamp, the substitute sweetener has been used to lower the caloric intake of the consumer when consuming the sweetened product. Therefore, to combine both sucralose and acesulfame K would not have provided a patentable feature over the prior art since the prior art teaches both of these compositions to be used for the same purpose.

- Regarding instant claims 141 and 142, on page 15 of the Appeal Brief, appellant states that there is no motivation provided by Google Groups to utilize sucralose in a packaged uncooked popcorn product. In fact, the reference specifically teaches away from such an arrangement in dealing only with the post-application of sucralose. In addition, it is respectfully submitted that the Examiner is wrong in the position that sugar and sucralose are equivalents.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Although Google Groups teaches adding sucralose after popping the popcorn, the

Examiner asserts that Google Groups is relied on as a generic teaching that sucralose has been a known substitute sweetener to sugar, which has been used on food products such as popcorn. This is not considered a teaching away but rather a generic teaching that sucralose was also available to the skilled artisan as an alternative low calorie sweetener to sugar. Mohlenkamp, as discussed above, teaches incorporating reduced calorie sugars and sugar substitutes such as aspartame and acesulfame K into food products that are prepared in a microwave oven. In combination with the knowledge of the ordinarily skilled artisan, it would have been obvious to use the sugar substitutes of Mohlenkamp and Google Groups in the food product of Ezzat for the purpose of providing low calorie alternative sweetening agents for the diet conscious consumer. Regarding appellant's assertion that the Examiner appears to be arguing that sucralose and sugar are equivalents, it is unclear as to where this has been stated in the Office Action. The Examiner has states that sweeteners exists as substitutes to sugar. This has been intended to indicate that sugar and sugar substitutes are both sweeteners intended to be used to sweeten a food product. The Examiner has not contended that sucralose and sugar are equivalents, but rather that alternatives to sugar have been utilized (i.e. as substitutes) for sweetening food products.

- Regarding instant claim 143, on page 16 of the Appeal Brief, appellant states that the Examiner has failed to provide the requisite suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings, and has failed to establish a reasonable expectation of success in combining the cited references. The Examiner noted that sweeteners exist as a substitute to sugar for diet conscious consumers, citing Google Groups; however this is not the same as sweeteners existing as substitutes for sugar in cooking. Numerous sweeteners available on the market cannot be utilized in the same manner as sugar. This is even more important when the cooking method being utilized is microwave energy.

The Examiner asserts however that since Mohlenkamp teaches microwave cooking with reduced calorie sweeteners such as acesulfame K, aspartame and saccharin, there would have been a reasonable expectation of success in adding a sugar substitute such as sucralose, as taught by Google Groups, prior to popping the popcorn of Ezzat, since these are all known sugar substitutes used for the same purpose. Even further still, Appellant has not provided any clear and convincing evidence of the thermal instability of microwave heating of the sugar substitute aspartame. Appellant further states the microwaving a food product would inherently produce hot spots which would not be the case in connection with baking a food product containing sucralose, however Mohlenkamp teaches using microwave energy to cook the food product. Appellant further states that there are particular circumstances, at least in connection with rapid and localized heating, that are relevant to food products being microwave and other food products; however the Examiner asserts that appellant has not provided any substantiation of these circumstances. Therefore, based on the teachings of Mohlenkamp and

Google Groups, the Examiner asserts that one having ordinary skill in the art would have had a reasonable expectation of success, absent any clear and convincing evidence to the contrary, of microwave cooking products that contain sugar substitutes, since Mohlenkamp teaches microwave cooking food products that use such sugar substitutes.

- On page 17 of the Appeal Brief, Appellant states that it is unclear as to why Callahan is needed in the mind of the Examiner. Appellant is further unclear as to the difference in rejecting claims 138-143 with and without Callahan. Appellant further questions how the combination without Callahan is also considered to render unpatentable various product claims but when Callahan is added, these limitations are apparently not met.

The Examiner respectfully asserts that the rejection of claims 138-143 is taken as a secondary approach in demonstrating that the instant claims are considered unpatentable. Due to the breadth of the claims and their broadest reasonable interpretation, the instant claims are still unpatentable over Ezzat, Mohlenkamp and Google Groups, with or without the teachings of Callahan et al. In further considering Appellants method and product, Callahan is also relied on as a secondary reference further teaching the concept of a method of adding an additive (sugar, cream) to a food product (coffee) and packaging the product (i.e. in a cup). Although Callahan is directed to a method of making coffee, Callahan also provides the generic teaching of a system and method for packaging a food product wherein the consumer provides input into the ingredients added to the food product. Ezzat teaches a method for adding popcorn

and packaging for distribution. Mohlenkamp teaches adding alternative reduced calorie sweeteners to sugar into food products which are subsequently microwaved and Google Groups teaches using sucralose as the alternative sweetener to sugar as a low caloric substitute. Based on these teachings it would have been obvious to the ordinarily skilled artisan to add an alternative sweetener, as taught by Mohlenkamp and wherein the sweetener is sucralose, as taught by Google Groups for the purpose of providing a low calorie alternative sweetener for health conscious consumers and those, such as diabetics, who cannot properly metabolize sugar (i.e. sucrose). As discussed above, Callahan is applied to teach the generic concept of a method of packaging a product wherein the consumer has input into the ingredients placed in the packaging. Therefore the teachings of Callahan suggest that it would have been within the skill of the ordinarily skilled artisan to apply such a method wherein the consumer has direct input into the ingredients added to the food product for the purpose of providing a "customized" food product.

- On pages 18-21 of the Appeal Brief, Appellant has substantially duplicated the comments applied to the rejections over Ezzat, Mohlenkamp and Google Groups, regarding instant claims 138-143.

Therefore, the Examiners response regarding instant claims 138 and 140, 139, 141 and 142, and 143 is taken as applied above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).


Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Viren Thakur
Examiner
Art Unit: 1761

Art Unit: 1761

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:


WILLIAM KRYNSKI
SPECIAL PROGRAM EXAMINER / Director TC1700
TECHNOLOGY CENTER 1700

Conferees:


Steve Weinstein


Gregory Mills